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REMARKS**Examiner Interview**

Applicant thanks Examiners Bates and Thompson for participating in the Examiner Interview on October 13, 2005. Applicant offers the following remarks concerning that interview and the subsequently provided Interview Summary Record.

During the interview, it was agreed that neither Robbins (U.S. Patent No. U.S. Patent No. 6,317,882) nor Wugofski (U.S. Patent No. 6,507,951) disclosed or suggested to one of skill in the art the claimed feature of "satellite audio radio." It is because the combination of the two references failed to suggest, much less disclose or enable, each and every claim limitation of the invention, that the rejections were improper. Accordingly, as a result of the interview, all previously outstanding rejections have been overcome.

However, to the extent that the Office asserts that the sole distinction between the claimed invention and Robbins (or any other art) rests solely with the claim limitation of "satellite audio radio," applicant respectfully disagrees and submits that the Office ignores other explicit claim limitations which are also patentably distinct from the art of record in each independent claim, as discussed below. Further, in the context of the interview on October 13, 2005, the sole limitation "satellite audio radio" was successfully used to illustrate the deficiencies of the Office's then outstanding obviousness rejection, and there was no need to discuss other limitations of the independent, much less dependent, claims.

Further, applicant respectfully disagrees with the statement that Rindsberg et al. (U.S. Patent No. 6,553,077) discloses the claimed invention in its entirety and a reading of the claims and a comparison of the reference and claims shows that Rindsberg et al. does not disclose all the features of the claims. Interestingly, the Office also recognizes this inaccuracy of the Interview Summary statement because the Office has not rejected all of the pending claims in light of the 102(e) reference, as illustrated below. Accordingly, applicant respectfully reserves the right to distinguish the claims over Rindsberg et al.

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Lastly, applicant respectfully asserts that although Fish et al. (U.S. Patent No. 6,925,576) may be relevant in the art, it has no relevance to the currently claimed invention.

In light of the interview, applicant responds to the outstanding Non-Final Office Action below.

Claim Rejection Under 35 U.S.C. § 102(e) Should Be Withdrawn

Claims 41-43, 47-48, 50-52, 58, 60-64, and 74-76 stand rejected under 35 U.S.C. § 102(e) as anticipated by Rindsberg et al. (U.S. Patent No. 6,553,077).

In response to the rejection, applicant provides herewith a declaration under 37 C.F.R. 1.131. The declaration includes facts showing a completion of the claimed invention in this country before the filing date of U.S. Patent No. 6,553,077. Specifically, the present non-provisional application was filed on August 3, 2001. The cited 102(e) reference was filed three days prior on July 31, 2001. The declaration asserts that an earlier version of the application describing the claimed invention was in the inventor's possession on and before July 27, 2001. As supporting evidence, applicant also provides an affidavit by a disinterested 3rd party. The affiant there indicates that he was provided with a copy of the application describing the claimed invention before the critical date, and that the Affiant assisted the inventor in finalizing the application for filing on August 3, 2001.

Given the mere three day difference between the filing dates of the present non-provisional application and the Rindsberg et al. reference, and the fact that the inventor is also the drafter of the application, the showing of facts are such that, in character and weight, they establish conception of the invention prior to the effective date of the reference coupled with diligence from prior to the July 31, 2001 date to a subsequent constructive reduction to practice on August 3, 2001.

Accordingly, applicant has antedated the Rindsberg et al. reference and respectfully requests withdrawal of the rejection.

Claim Rejections Under 35 U.S.C. § 103 Should Be Withdrawn

Claims 41-43, 45, 47, 48, 50-53, 55-56, 58, 61-64, 74-76 and 81 stand

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rejected under 35 U.S.C. § 103 as unpatentable over Robbins, U.S. Patent No. 6,317,882, in view of Brown et al., U.S. Patent No. 6,397,076, in further view of Owens et al., U.S. Patent No. 6,067,278 for the reasons set forth on pages 7 through 19 of the Non-Final Office Action. Claims 46 and 57 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown et al. and Owens et al., in further view of Barton, U.S. Patent No. 6,233,389. Claims 49, 59, 79, and 80 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown et al. and Owens et al., in further view in further view of Wall, U.S. Patent No. 6,055,244. Claim 77 stands rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown et al. and Owens et al., in further view of Marko et al., U.S. Patent No. 6,154,452.

In the present response, claims 41, 74, 75, 76 and 77 have been amended.

As the MPEP § 2142 indicates, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For the following reasons, the claims are patentable in view of the art of record. First, the combination of references fails to suggest, much less disclose, each and every claim limitation of the independent claims, much less the dependent claims. Second, and assuming solely for the sake of argument that the combination of references does disclose each limitation, the Office has failed to establish a *prima facie* case for obviousness because there is no motivation, suggestion or teaching, other than from applicant's disclosure, to modify or combine the reference teachings.

1. The Combination of References Does Not Disclose, Teach, or Suggest All of the Claim Limitations

With respect to each independent claim, the Office asserts that it would have been obvious to one of ordinary skill in the art to use Brown et al.'s teaching and combine it with Robbins' disclosure in order to improve Robbins to include satellite

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audio radio broadcasts with all the other types of broadcast communication that are enabled with the functionality of Robbins' alert and recording system. The Office also cites Owens et al. for the limited proposition of time shifting in an automobile.

Accordingly, Applicant submits that none of the references cited in the rejection support the obviousness of the invention because even if combined in the manner suggested, each independent claim of the instant patent application still recites features that are not disclosed or suggested.

1A. The Distinctions Over the References Are Explicit in the Claims

To exemplify the distinctions between the claimed invention and the proposed combination of Robbins and Brown et al., a relevant portion of each independent claim is set forth below. It is understood that each of the independent claims, as a whole, are also limited to mobile receivers and "satellite audio radio"

i) Independent claim 41 recites in part:

"receiving on a mobile receiver a plurality of stations, each station comprising a digitally encoded stream containing a designation representative of a work of authorship that is being broadcast over a global communication network, said global communication network having a plurality of stations;

decoding a selected station from among the plurality of stations;

comparing the decoded station with a user designated work of authorship to determine an indication that the user designated work of authorship is playing on the decoded station"

ii) Independent claim 43 recites in part:

"wherein at least one broadcast station contains a station designation of a work of authorship as an indication of a work of authorship contained in a signal from the broadcast station," and

"comparing the user designation of a work of authorship with the station designation of a work of authorship at 0.01 second to 3 minute intervals"

iii) Independent claim 52 recites in part:

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“wherein at least one station broadcast contains a designation of a work of authorship as an indication of content of the station broadcast” and
“...selectively store a user designation of a work of authorship in a memory”

iv) Independent claim 61 recites in part:

“comparing information on one or more of the received digital satellite audio radio channels with a user designated work of authorship to determine whether the user designated work of authorship is playing on one or more of the digital satellite audio radio channels”

v) Independent claim 74 recites in part:

“the general purpose computer is also configured to receive data indicating what is being played on each channel; wherein the general purpose computer further includes a memory, the memory includes a playlist of user designated works of authorship”

vi) Independent claim 75 recites in part:

“using a mobile receiver to receive one or more digital satellite audio radio stations and data wherein the data indicates what work of authorship is being played on the one or more digital satellite audio radio stations” and
“inputting a designation of a user desired work of authorship into a memory”

vii) Independent claim 76 recites in part:

“using a mobile receiver to receive information from a satellite wherein the information indicates which works of authorship are being broadcast on each channel of at least 100 digital satellite audio radio channels”
“comparing the information with a user designated work of authorship”

Given the number of independent claims at issue, the fact that the same general rejection is repeated for the independent claims, and because applicant asserts

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that the claim limitations can be distinguished via the same facts and arguments, the independent claims will be discussed together in a general context.

1B. The Claimed Invention Is Patentably Distinct From the Proposed Combination of Robbins, Owens et al., and Brown et al.

Here, the Office has not given due weight to (1) the explicit claim limitations (e.g., the limitations set forth above), as well as (2) how the invention is claimed as a whole. Instead the Office has chosen to focus solely on the limited teachings of Brown et al. and asserted that by merely including the teachings of Brown et al. in Robbins, one arrives at the claimed invention.

As the Office is aware, a patent claim is obvious when the differences between the claimed invention and the prior art "are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art" 35 U.S.C. § 103; see also *Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S. Ct. 684, *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir 1999). Further, as the MPEP § 2143.03 indicates, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1964). All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (emphasis added).

As stated above, the Office recognizes that Robbins fails to disclose or suggest to one skilled in the art to include digital satellite audio radio within its scope and thusly, Robbins is deficient in that it necessarily fails to disclose, suggest or enable applicant's claims which generally recite receiving a satellite audio radio signal from a digital audio radio satellite on a mobile receiver, wherein the information corresponds to works of authorship playing on one or more channels, as in independent claims 41, 43, 61, 75 and 76, much less the devices/apparatuses configured to receive satellite audio radio and other information as in independent claims 74 and 52.

Moreover, Robbins fails to teach including additional information with the satellite audio radio signal which can be used to compare what is playing on one or more channels with a user designated work of authorship.

Furthermore, in view of the limited purpose for which Owens et al. is offered as indicated in the Office Action, applicant submits that (1) none of the

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independent claims are directed to time shifting, and (2) Owens et al, is merely cumulative to the teachings of Robbins, and therefore because Robbins is overcome for all the reasons set forth herein, Owens et al. is also necessarily overcome.

As stated on page 8 of the Office Action and elsewhere in the Office Action, the claims stand rejected in light of Brown et al. because Brown et al. teaches a system with a receiver for receiving audio channels that includes searching for ID codes in channels and using those ID codes to alert users, where the audio channels include digital satellite audio radio. However, the Office overlooks the fact that the ID codes and other disclosures of Brown et al. are far different from what is described in Robbins, and even more so from what is claimed by applicant.

This is because Brown et al. merely teaches a fixed register that is loaded with one or more previously stored dispatch ID codes. When equality is found between the stored radio ID codes and a dispatch ID code, a signal is coupled to the controller indicating such equality, as described at column 5, lines 43-55 of Brown et al. The controller directs the channel select switch to decode the appropriate dispatch broadcast signal and to revert back to a previously selected broadcast channel for resumption of the program originally selected by the user, as described at column 5, lines 56 through column 6, line 18. In other words, when Brown et al. is followed, the controller of Brown et al. automatically changes to a dispatch message channel, and then later automatically switches back.

As described at column 3, lines 5-20 and column 5, lines 32 through 41 of Brown et al., previously assigned, unique or common stored dispatch ID codes identify a radio or radios that are targeted to receive a particular dispatch message. This allows a user of a receiver to receive messages addressed to that particular receiver's assigned, unique and/or common dispatch ID code and thereby excludes other users (whose receivers do not include the appropriate dispatch ID code) from accessing the dispatch message. For example, in the case of a fleet, each of the receivers in the fleet are programmed with the same assigned dispatch ID code so that each is enabled to receive messages common to that fleet, as explained at column 3, lines 17 to 20.

Of most relevance here is the fact that Brown et al. does not suggest, much less disclose, ID codes or any other technique which identifies or corresponds to user

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designated works of authorship in a digital satellite audio radio context, or the use thereof. Further, Brown et al. does not suggest, much less disclose using an ID code or other technique to assist a user in finding a user designated work of authorship playing on a satellite audio radio channel, as presently claimed.

On this basis, Robbins, Owens et al., and Brown et al., alone or in combination, fail to teach a mobile (i.e., by employing, e.g., broad beam width receivers/antennas and satellites) device or method for searching for user designated works of authorship in a digital satellite audio radio context, as embodied by the claims.

Accordingly, for the foregoing reasons Brown et al. fails to cure the deficiencies of Robbins, and the proposed combination fails to provide all the claim limitations of each independent claim as required by 35 U.S.C. § 103. It is because the references, alone or in combination, fail to suggest or teach a mobile device or method for searching for user designated works of authorship in a digital satellite audio radio context, the rejection is insufficient to render the claims obvious and therefore applicant respectfully requests withdrawal of the rejection.

2. The Office Has Not Shown Any Suggestion, Teaching or Motivation That Would Lead a Person of Ordinary Skill In The Art to Combine the Relevant Art Teachings in the Manner Claimed

Assuming for the sake of argument that when combined Robbins, Brown et al. and Owens et al. disclose or suggest each and every independent claim feature, applicant submits that the Office has not shown any suggestion, teaching or motivation that would lead a person of ordinary skill in the art to combine the relevant art teachings in the manner claimed.

As the Office is aware, to reject claims in an application under § 103, an examiner must show an un rebutted *prima facie* case of obviousness. *See In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

“The ultimate determination of whether an invention would have been obvious under 35 U.S.C. § 103(a) is a legal conclusion based on underlying findings of

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fact." *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. *See Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

When a rejection depends on a combination of prior art references, as here, there must be some teaching, suggestion, or motivation to combine the references. *See In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Although the suggestion to combine references may flow from the nature of the problem, *see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), the suggestion more often comes from the teachings of the pertinent references, *see In re Sernaker*, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983), or from the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field, *see Pro-Mold*, 75 F.3d at 1573 (citing *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985)). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *See In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

Here the Office contends that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to use Brown et al.'s teaching and include it in Robbins' disclosure in order to improve Robbins to include satellite audio radio broadcasts with all the other types of broadcast communication that are enabled with the functionality of Robbins' alert and recording system."

As noted above, the Office recognizes that Robbins alone fails to disclose or suggest to one skilled in the art to include digital satellite radio within its scope. Thus, the objective evidence supplied by the Office for the combination must come from

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elsewhere. In the present case, the Office has not pointed to anything objective in Brown et al., much less the prior art as a whole or even generally available knowledge, to suggest the desirability, and thus the obviousness, of making the combination. In fact, for the following reasons, applicant submits that a suggestion of such desirability does not exist.

2A. The Office Wrongly Picks and Chooses Elements, and Further There Is No Reasonable Expectation of Success of Arriving at the Claimed Invention

In *In re Wesslau* (1965), the CCPA cautioned that "it is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Although applicant does not dispute the Office's recognition that the present invention constitutes an improvement over Robbins, the Office's rejection is nonetheless improper because it takes features of Brown et al. out of context with what Brown et al. fairly teaches and suggests and then reasons that such a combination would actually improve Robbins. However, such reasoning is misplaced because the ID codes of Brown et al. identify receivers having access to a dispatch message, as described above.

How then, at the time of filing, would one of skill in the art have considered Brown et al. as *improving* Robbins when Brown et al. is directed to restricting and automatically controlling user access to dispatch messages by third parties, whereas Robbins is directed to enhancing and facilitating user access to content? Applicant submits that one of skill in the art would not view the teachings of Brown et al. as even remotely improving Robbins because Brown et al. restricts or screens user access to content, and therefore there is no suggestion as to the desirability of the combination, much less combining them in the manner claimed.

Furthermore, because the ID codes of Brown et al. control access to dispatch messages and do not correspond to user designated works of authorship, there

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can be no reasonable expectation of success of arriving at the claimed invention by the proposed combination. More specifically, because the teachings of both Robbins and Brown et al. fail to teach or suggest how to search for user designated works of authorship in a satellite radio context (through the use of ID codes or other techniques), applicant submits that there can be no expectation of success in the Office's proposed modification.

Here, and as in *In re Wright* (1989), the Office's attempt to show a suggestion of the claimed invention requires taking statements wholly out of context and giving them meanings they would not have had to one skilled in the art having no knowledge of applicant's invention, or for that matter to anyone else who can read the specification with understanding. This is because the ID codes used in Brown et al. do not correspond in any way to the content of the dispatch message and thus they do not correspond to particular works of authorship for which a user might search. Accordingly, applicant submits that nothing in Brown et al. suggests a desirability of a combination with Robbins.

Quite to the contrary, one of skill in the art would find the resultant combination undesirable because of the following: (i) the ID codes restrict and control user access to channels and information, (ii) Brown et al. automatically directs users to other channels, thus it operates outside of user control and (iii) the ID codes used in Brown et al. do not correspond to a designation of a work of authorship. Further, there is no reasonable expectation of success in the combination because the ID codes of Brown et al. do not correspond to user designated works of authorship, but rather merely identify receivers.

Accordingly, applicant respectfully requests withdrawal of the rejection.

2B. The Combination Renders Robbins Unsatisfactory for Its Intended Purpose and Therefore No Suggestion for the Combination Exists

As stated in the MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, the proposed modification renders the Robbins invention unsatisfactory for its intended purpose.

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More specifically, the proposed modification not only renders Robbins unsatisfactory for its intended purpose, it destroys the intended functionality of Robbins. Robbins stores an ID code that is broadcast with the program that is currently playing, wherein the ID code corresponds to the program that is broadcast (i.e., the ID code corresponds to the content), see e.g., column 6, lines 64 to 67 of Robbins. The Robbins ID code functions to facilitate user access to specified content of predetermined programs.

Factually, the ID codes of Brown et al. do not correspond to the content of particular programs currently being broadcast or to user designated predetermined programs, and thus the teachings of Brown et al. differ significantly from Robbins. Brown et al. indicates that the ID codes are provided independent of the content of the dispatch message, as described at column 5, lines 43 to 47, and therefore a single ID code stored on a receiver causes a receiver to change channels in response to multiple/different dispatch messages.

To modify Robbins using the teachings of Brown et al. would eliminate user control and restrict channel access unless an appropriate ID code is previously stored (see e.g., column 2, lines 54 to 60, and column 5, lines 43 to 47 of Brown et al), thereby destroying the functionality of Robbins. In short, Robbins is concerned with facilitating user access to channel programming, whereas Brown et al. targets users by excluding other users from being able to access dispatch message channels when certain dispatch messages are broadcast.

Therefore, even if the references were combined in the manner suggested, it is clear that (i) Brown et al.'s teaching is in direct contravention to the teachings of Robbins, and (ii) the combination destroys Robbins' intended functionality.

Accordingly, there can be no motivation to combine these references, and applicant respectfully requests withdrawal of the rejection.

2C. The Office Has Fallen Into the Hindsight Trap

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Dembiczak*, 175 F.3d at 999. This is because "[c]ombining prior art

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references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability- the essence of hindsight." *Id.* Therefore, the courts have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab* ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed" (emphasis added). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Although the MPEP at § 2145 indicates that "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning," here it is clear that the Office has once again engaged in *impermissible* hindsight and has improperly used applicant's non-limiting disclosure and prophetic examples as a blueprint, and included knowledge gleaned only from applicant's disclosure for the rejection. This is because in the absence of applicant's disclosure, a person of ordinary skill in the art would have had no motivation to combine the prior art teachings, much less have had motivation to combine the prior art teachings in the particular manner claimed for all the reasons described hereinabove.

Further, a statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

In the present case, the Office points to no objective evidence that supports the proposed combination, much less any evidence to arrive at the invention in

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the particular manner claimed. The Office merely states that it “would have been obvious to one of ordinary skill in the art at the time the invention was made to use Brown et al.’s teaching and include it in Robbins’ disclosure in order to improve Robbins to include satellite audio radio broadcasts with all the other types of broadcast communication that are enabled with the functionality of Robbins’ alert and recording system.”

As the court stated in *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998), “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” (emphasis added). Broad conclusory statements standing alone, such as the one made in the Office Action to support the § 103 rejection here, are not “evidence.” See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Here, the statements made by the Office, and in particular the statements concerning the ID codes of Brown et al., amount to no more than conclusory statements and convenient assumptions about skilled artisans, and fail to take into consideration the actual teachings of Brown et al., and are therefore insufficient to support the § 103 rejection.

Applicant’s assertion that the Office has once again used improper hindsight is particularly telling when one considers that (i) even if the references were to be combined, one skilled in the art would not arrive at the claimed invention, as describe in Part 1, (ii) that the Office has improperly focused on only so much of Brown et al. as to support the Office’s position, to the exclusion of other parts of Brown et al. necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art, (iii) the teachings of Brown et al. render Robbins unsatisfactory for its intended purpose, (iv) the combination of Robbins with Brown et al. does not disclose or suggest searching for user designated works of authorship in a satellite audio radio context, (v) Brown et al. fails to provide a motivation for a combination with Robbins and vice versa.

Accordingly, applicant respectfully requests withdrawal of the rejection.

3. Summary

In summary, Robbins, Brown et al. and Owens et al. are all deficient in that none suggest, much less disclose, the claimed invention *as a whole*.

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Further, (1) Brown et al. does not provide any motivation, teaching or suggestion for a combination with Robbins or to modify Robbins in any way, and (2) there is no reasonable expectation of success, absent applicants disclosure, of arriving at the claimed invention by the proposed combination because the ID codes of Brown et al. merely identify receivers, not works of authorship. Accordingly, applicant respectfully submits that the Office has not set forth a prima facie case of obviousness.

Based on the teachings of the references, there is no such relevant evidence as a reasonable mind might accept as adequate to support the conclusion of obviousness of the claims. Although applicant takes issue with what the Office indicates Brown et al. teaches, even if the teachings were as the Office suggests there is no substantial evidence to extrapolate this teaching to modify Robbins in any manner to arrive at the claimed invention. Therefore the rejection under 35 U.S.C. § 103 is improper and applicant respectfully requests that the rejection be withdrawn with respect to independent claims 41, 43, 52, 61, 74, 75 and 76.

Lastly, because claim 42 depends upon allowable claim 41, claims 45, 46, 47, 48, 49, 50, and 51 depend upon allowable claim 43, claims 53, 55, 56, 57, 58, 59, and 60 depend upon allowable claim 52, claims 62, 63 and 64 depend upon allowable claim 61, and claims 77, 78, 79, 80, and 81 depend upon allowable claim 76, under the doctrine set forth in *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), these dependent claims are also allowable by virtue of the claims dependency upon allowable base claims and thus the rejections in light of Barton, Wall and Marko et al. have also been overcome.

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Conclusion

Applicant respectfully submits that all claim rejections have been overcome and that all pending claims are now in condition for allowance, early notice of which is earnestly solicited.

Respectfully Submitted,

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